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EXAMINER

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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* WERNER ZAGLER
11

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13 Appeal 2007-0840
14 Application 09/803,360
15 Technology Center 2600
16

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18 Oral Hearing Held: January 23, 2008
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21 Before JAMES D. THOMAS, LANCE LEONARD BARRY, and
22 MAHSHID D. SAADAT, *Administrative Patent Judges*.
23

24 ON BEHALF OF THE APPELLANT:
25

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33 P R O C E E D I N G S

34 MS. HALL: -- 2007-0840. The attorney is Mr. Jeff Sanok.

35 JUDGE THOMAS: Thank you. Counselor?

36 MR. SANOK: Good afternoon.
37

1 JUDGE THOMAS: Judge Lucas is sitting in for observation on this
2 appeal.

3 MR. SANOK: Okay.

4 JUDGE LUCAS: Welcome.

5 JUDGE THOMAS: I assume you've been here before.

6 MR. SANOK: Yes, a few times.

7 JUDGE THOMAS: So you know the rules. All right. You may
8 proceed at any time.

9 MR. SANOK: My name's Jeff Sanok, representing the Appellant,
10 BMW. Hopefully I'll be very, very brief. This is the second time this case
11 has been on appeal here. After the first decision we went back to the
12 Examiner to try to address what we perceived as the deficiencies in our
13 claims the last time to try to define the prior art and we'd reached a stage
14 where we thought we'd done and the Examiner disagreed, so we're on appeal
15 again.

16 Essentially there's three independent method claims here. I'm just
17 going to address Method Claim 1 because the limitations carry over in the
18 apparatus as well as the software product claim. I apologize. I'm suffering
19 from a bit of a cold, so it's hard to talk right now -- much louder than I can
20 right now.

21 JUDGE BARRY: If you need any water to soothe your throat there.

22 MR. SANOK: Oh, I think I should be okay. I hope I'm not here too
23 long. I'm just going to sort of pull this right up here. Essentially we have a
24 method for entering a vehicle in a tight space, and the main claims have been

1 rejected as being obvious over a German document. We call it Boehm,
2 which is written at the top here.

3 The method has three simple steps -- oh, thank you -- three simple
4 steps to facilitate entry into the vehicle. The first one is that you're going to
5 use your -- some sort of a operating device such as this and give a double
6 unlock command that we're sort of familiar with doing in terms of opening
7 all doors of a car.

8 The second is then simultaneously or subsequently you're going to
9 open the door, and as soon as those two acts occur the window will
10 automatically lower completely without requiring any further action by the
11 user. The idea, of course, is to be able to -- if you're in a tight space, and
12 with cars nowadays that have angled windows, to be able to lower the
13 window completely so that you can squeeze in and sort of use the space
14 above the window for your body to get in.

15 The prior art that I've shown here has a method that's somewhat
16 similar, but they essentially require a further user action, and that's the
17 limitation that we added following the first appeal.

18 As I've shown here, this patent to Boehm describes two paths. One
19 path, assuming you take the unlock command, and we've, you know, agreed
20 it could be a double unlock command, and then you open the door, nothing
21 happens. You have to get in. The window stays up. So right there if you
22 applied our steps, our invention would not occur. What Boehm shows in the
23 other path, which is on this side that I highlighted in pink, is that there has to
24 be some further conscious act by the user to get the vehicle window to

1 lower, and that is you do the double -- you do the unlock command. You
2 open the door and, as you're doing that, you have to consciously hold in this
3 case the door handle -- there's a handle switch -- hold it in a raised position
4 for a second to cause the window to lower, essentially giving you a separate
5 triggering act for lowering the window that's not necessary in the BMW
6 invention.

7 JUDGE BARRY: Isn't holding the handle part and parcel opening the
8 door?

9 MR. SANOK: No. Well, you know, I think that's where we've been
10 going back and forth with the Examiner, but certainly you do hold a handle
11 to open the door, but you're not doing it for any prescribed length of time. If
12 that was the case their reference would not work because what would be
13 happening is every time you open the door your window would go down.
14 That's not what they intend.

15 So this path teaches away from what we are doing. We are trying to
16 actually, you know, automatically lower the window as soon as you lift up
17 the handle, and that's not what occurs in Boehm, so we think it teaches
18 away.

19 Now there are other differences that come into play which is a result
20 of, you know, how we're arming the system to do that, which is we're using a
21 double unlock command to do that to our control unit. You know, that
22 receives a double unlock command and now it just waits for the door to
23 open. As soon as it opens it lowers.

1 That's not what they're doing. What the Boehm reference is doing is
2 simply unlocking the door with a single unlock command. Now we readily
3 admit using double unlocks are okay or something someone could do, but
4 when you start to combine a double unlock command here with an opening
5 of the door with an additional user action to get it to lower, you start getting
6 pretty far a field from what BMW is trying to do in a very simplified manner
7 which is I'm coming up to my car. It's in a tight spot. I'm not going to click
8 it just once. I know that if I click it twice as soon as I hit the handle it's
9 going to go down and I'm going to get in. It's going to make it a lot easier.

10 So the user doesn't have to think when he gets up to the door and says
11 okay, now what do I want to do? Oh, I'm going to, you know, try to activate
12 it in a different way. It's just much more automatic. It's much easier. It also
13 is more advantageous in terms of getting the window to lower and get out of
14 the way for purposes of avoiding the seals that are around a frameless, you
15 know, window. It gets it out of the way quicker which might not occur in
16 Boehm. Boehm's path on this side literally could, you know, damage the
17 seal when it opens it up.

18 JUDGE SAADAT: In Step 2, the action refers to opening in that box.

19 MR. SANOK: In our Step 2 --

20 JUDGE SAADAT: No, no, the reference.

21 MR. SANOK: Oh, in the reference. They have -- no. The unlock
22 command here, which is what is shown in their reference on both paths, is
23 essentially what they would use as sort of a remote trigger to say okay,
24 unlock the door. They say open. Then they open the door. And that's what

1 happens on this path and the window does not lower. On this path they send
2 the unlock command, you go to open the door, and then you consciously do
3 something further and that is the deliberate act that we are trying to claim
4 out of our claim.

5 JUDGE SAADAT: So you are separating those two actions?
6 Opening the door and closing it, according to your argument, are two
7 separate actions by the user?

8 MR. SANOK: Yes, because they are two separate deliberate actions.
9 And I think if you look at the translation that the PTO provided of the
10 Boehm reference, you know, it even describes that this is a -- you know,
11 after the vehicle has been opened, the window then can be lowered as a
12 result of the protracted activation of the external handle button.

13 JUDGE BARRY: Where are you reading, counsel?

14 MR. SANOK: This is on page 6, about midway, the paragraph that
15 starts as a result.

16 JUDGE BARRY: Okay.

17 MR. SANOK: You have it -- it describes a protracted activation.
18 That's an additional user action. You can also go to page 10 at the bottom
19 and it talks about -- where was it -- excuse me, not page 10, page 8, about
20 lines 6 and 7. It talks about a deliberate lowering of the window pane.
21 Again, these are conscious user actions that we are not saying is part of our
22 claim and we tried to claim it that way by the further amendments after the
23 first appeal.

24 JUDGE BARRY: Counsel, back to page 6 of that reference --

1 MR. SANOK: Yes.

2 JUDGE BARRY: -- what does that first sentence mean where it says
3 from outside of the vehicle door still closed after the vehicle has been
4 operated? What does it mean that the vehicle door is closed but the vehicle
5 itself is open?

6 MR. SANOK: I think they're referring -- they're using open in the
7 sense that we would probably say unlocked, but then you have to then open
8 the door in the next part and then do a protracted action.

9 JUDGE BARRY: Where is that that you open the door before you do
10 the protracted action?

11 MR. SANOK: Well, it's simply where you have here the window
12 pane can be lowered as a result of the protracted activation of the external
13 handle button, so you're holding it up. I mean it could be holding it up
14 simply in the switch, and I would argue then there's no opening at the door
15 even here. Our reference, of course, talks about when you look at the
16 embodiment. You know, we have a door contact switch that's actually used
17 to say -- as soon as that door contact switch opens, that's the opening of the
18 door in our sketch, so I think that arguably you could say it's even further
19 removed here.

20 But I think if you look at Boehm and you compare it with it describes
21 on the other path, it's really saying, you know, you open the handle and you
22 pull open the door, and under normal operation you have no problem, the
23 window's not going to lower because that's not something you would want to
24 happen every single time you opened the door.

1 So I think there's -- I mean there's a lot of those types of differences in
2 our -- you know, our claim was trying to figure out how to claim around this
3 reference for sure, which is what we tried to do. I don't have anything
4 further.

5 JUDGE BARRY: Any other questions from the panel? Comments?
6 All right. Thank you very much, sir.

7 MR. SANOK: Thank you very much.
8 (Whereupon, the proceedings concluded.)

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Appeal 2007-0840
Application 09/803,360

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